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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alexander Shipp

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EXAMINER

PHAM, MICHAEL

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,957	<b>Applicant(s)</b> SHIPP, ALEXANDER	
	<b>Examiner</b> MICHAEL PHAM	<b>Art Unit</b> 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### *Note*

1. Application is hereby re-opened due to pre-mature finality.

### *Claim Status*

2. Claims 1, 3-7, and 9-13 are pending and have been examined.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 3-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **MPEP 2106:**

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material". Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e. abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an

Art Unit: 2167

algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer"

Claim 1 recites "a computer system". However, claim 1 fails to contain any computer hardware that is used to implement the system so as to realize its functionality. Thus, the body of claim 1 is merely an abstract idea and is being processed without any links to a practical result in the technology arts and without any computer hardware manipulation. Contrary to arguments made by some Applicants, use of the word "computer system" does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. Claims 3-6 fail to resolve the deficiencies of claim 1 and are therefore rejected.

5. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material". Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Art Unit: 2167

Merely claiming nonfunctional descriptive material, i.e. abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer"

Claim 13 recites "a computer system". However, claim 1 fails to contain any computer hardware that is used to implement the system so as to realize its functionality. Thus, the body of claim 13 is merely an abstract idea and is being processed without any links to a practical result in the technology arts and without any computer hardware manipulation. Contrary to arguments made by some Applicants, use of the word "computer system" does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-7, 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication Number 2004/0088570 issued to Guy William Welch Roberts et al (hereafter Roberts) in view of US Patent 6721721 by Bates et. al. (hereafter Bates).

**Claim 1:**

Roberts discloses the following claimed limitations:

“a) means for generating data with regard to the file to characterize its identity and for thereby referencing a computer database to determine whether it is an instance of a known file” [0033 lines 8-12, removing the internet address from the currently held data (e.g. stripping the internet address from the e-mail or the data file and possibly replacing it with a marker indicating that it has been removed because it pointed to malware.). 0034, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). Accordingly, means for generating data (marker) with regard to the file (data) to characterize its identity (pointed to malware) and for thereby referencing a computer database (database) to determine whether it is an instance of a known file (identifying malware free content)]

“b) means for selectively subjecting the file to a number of heuristic procedures to determine whether or not it contains, or is likely to contain, malware” [0037-0038, and Figure 6, elements 42-48. Accordingly, b) means for selectively subjecting the file to a number of heuristic procedures (figure 6 elements 42-48) to determine whether or not it contains, or is likely to contain, malware (figure 6 element 46)]

Art Unit: 2167

“c) means for determining, in dependence upon the record, if any, of the file in the database, whether the file can be regarded as safe in dependence on factors”[0034, lines 1-7, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). figure 6. Accordingly, c) means for determining (figure 6), in dependence upon the record (database), if any, of the file in the database (database storing internet addresses that have been pre-emptively scanned), whether the file can be regarded as safe (identifying malware free content, figure 6 step 50) in dependence on factors (date, filesize, checksum)]

“and for controlling the means b) such that the file, if the file is to be regarded as safe, is either subject to less thorough processing than if it were not so regarded or not subject to processing by the means b) at all” [0034, lines 1-7, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). 0037 lines 12-16, if the checksums match then the webpage may be assumed to not have been changed in the intervening period and not require rescanning for malware prior to being returned to the requester. Accordingly, and for controlling the means b) such that the file (data/webpage/content), if the file is to be regarded as safe (malware free content), is either

Art Unit: 2167

subject to less thorough processing than if it were not so regarded or not subject to processing by the means b) at all (not require rescanning) is disclosed ].

Roberts does not explicitly teach factors including the “length of time which the database indicates that the file has been known without malware-containing instances of it being detected.”

On the other hand, Bates discloses if the URL was not found to be untrustworthy, control passes to block 98 to determine whether a "good" url threshold time has past-that is, whether an excessive period of time has elapsed since the URL was last virus checked. Figure 3 elements 96-99Accordingly, the length of time (threshold time) which the database indicates that the file has been known without malware containing instances (virus) of it being detected (virus in the past).

Both Roberts and Bates are directed to the same field of endeavor as applicant's invention. Both are directed to improving virus scanning systems. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have applied the disclosure of Bates above to the disclosure of Roberts for the purpose of reducing the time of scanning for a virus, and to ensure that virus status information for URL's in the virus database is kept relatively current (Bates, col. 14 lines 1-5).



Art Unit: 2167

**Claims 3 and 9:**

As per claims 3 and similarly claim 9, the combination of Roberts and Bates disclose in Roberts: “wherein the means c) performs said determining of whether a file can be regarded as safe in dependence on factors including sources, recorded in the database, from which instances of the file have originated” [paragraph 34, lines 1-6, Internet address]

**Claims 4 and 10:**

As per claims 4 and similarly claim 10, the combination of Roberts and Bates disclose in Roberts: “performs said determining of whether a file can be regarded as safe in dependence on factors including the number of times, recorded in the database, instances of the file have been processed” [paragraph 37, lines 8-18, checksum comparison and a mechanism which uses dates and other information to determine currency and status]

**Claims 5 and 11:**

As per claims 5 and similarly claim 11, the combination of Roberts and Bates disclose in Roberts: “means for updating the database in dependence upon the result of the processing of the file by the means b)” [paragraph 33, virus found actions include updating]

**Claims 6 and 12:**

As per claims 5 and similarly claim 11, the combination of Roberts and Bates disclose in Roberts: “wherein the updating of the database, is operative in the event of the means b) determining that the file contains, or is likely to contain, malware to delete the record of the file

Art Unit: 2167

in the database or to update the record of the file in the database so that the file no longer is taken be safe” [paragraph 33, virus found actions].

**Claim 7:**

As per claim 7, similar as claim 1 above and Roberts further teaches storing the determination of whether or not the file contains, or is likely to contain malware [0034, lines 1-7, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc.) Accordingly, disclosing storing the determination of whether or not the file contains or is likely to contain malware (store data identifying malware free content)]

**Claim 13**

As per claim 13 Roberts discloses the following claimed limitations:

“an engine that generates data with regard to the file to characterize its identity and for thereby referencing a computer database to determine whether it is an instance of a known file” [0033 lines 8-12, removing the internet address from the currently held data (e.g. stripping the internet address from the e-mail or the data file and possibly replacing it with a marker indicating that it has been removed because it pointed to malware.). 0034, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with

Art Unit: 2167

the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). Accordingly, an engine (step 30) that generates data (marker) with regard to the file (data) to characterize its identity (pointed to malware) and for thereby referencing a computer database (database) to determine whether it is an instance of a known file (identifying malware free content)]

“that processes the file by selectively subjecting the file to a number of heuristic procedures to determine whether or not it contains, or is likely to contain, malware” [0037-0038, and Figure 6, elements 42-48. Accordingly, that processes the file by selectively subjecting the file to a number of heuristic procedures (figure 6 elements 42-48) to determine whether or not it contains, or is likely to contain, malware (figure 6 element 46)]

“and that determines, in dependence upon the record, if any, of the file in the database, whether the file can be regarded as safe in dependence on factors including the length of time for which the database indicates that the file has been known without malware- containing instances of it being detected” [0034, lines 1-7, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). figure 6. Accordingly, and that determines, in dependence upon the record (database), if any, of the file in the database (database storing internet addresses that have been

Art Unit: 2167

pre-emptively scanned. 0034, lines 8-10, data referred to by the internet addresses may also be stored), whether the file can be regarded as safe (identifying malware free content, figure 6 step 50) in dependence on factors (date, filesize, checksum)]

“and for controlling the processing to which the file is subjected such that the file, if the file is to be regarded as safe, is either subject to less thorough processing than if it were not so regarded or not subject to the processing at all” [0034, lines 1-7, store data identifying malware free content that may be accessed over the internet. This may take the form of a database storing internet addresses that have been pre-emptively scanned for malware content in accordance with the previous steps and found not to contain malware (together with page version identifying data such as date, filesize, checksum, etc). 0037 lines 12-16, if the checksums match then the webpage may be assumed to not have been changed in the intervening period and not require rescanning for malware prior to being returned to the requester. Accordingly, and for controlling the processing to which the file is subjected such that the file (data/webpage/content), if the file is to be regarded as safe (malware free content), is either subject to less thorough processing than if it were not so regarded or not subject to processing at all (not require rescanning) is disclosed ].

Roberts does not explicitly disclose dependence on factors including the “length of time for which the database indicates that the file has been known without malware-containing instances of it being detected”

On the other hand, Bates discloses if the URL was not found to be untrustworthy, control passes to block 98 to determine whether a "good" url threshold time has past-that is, whether an excessive period of time has elapsed since the URL was last virus checked. Figure 3 elements 96-99. Accordingly, the length of time (threshold time) which the database indicates that the file has been known without malware containing instances (virus) of it being detected (virus in the past).

Both Roberts and Bates are directed to the same field of endeavor as applicant's invention. Both are directed to improving virus scanning systems. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have applied the disclosure of Bates above to the disclosure of Roberts for the purpose of reducing the time of scanning for a virus, and to ensure that virus status information for URL's in the virus database is kept relatively current (Bates, col. 14 lines 1-5).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3-7, and 9-13 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's mainly asserted "in dependence on factors including the length of time for which the database indicates that the file has been known without malware-containing instances of it being detected" is not disclosed by Miyata.

Art Unit: 2167

In response, this is now moot. Bates discloses if the URL was not found to be untrustworthy, control passes to block 98 to determine whether a "good" url threshold time has past-that is, whether an excessive period of time has elapsed since the URL was last virus checked. Figure 3 elements 96-99. Accordingly, the length of time (threshold time) which the database indicates that the file has been known without malware containing instances (virus) of it being detected (virus in the past).

### ***Conclusion***

9. The prior art made of record listed on pto-892 and not relied, if any, upon is considered pertinent to applicant's disclosure.

### ***Contact Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PHAM whose telephone number is (571)272-3924. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2167

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./  
Examiner, Art Unit 2167

/John R. Cottingham/  
Supervisory Patent Examiner, Art Unit  
2167